UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,649	08/27/2001	Helen O'Hara	021058/0257402	3549

909 7590 04/06/2004

PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER	
MILLER, EDWARD A	
ART UNIT	**PAPER NUMBER**
3641	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/938,649	O'HARA ET AL.	
	Examiner	Art Unit	
	Edward A. Miller	3641	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☒ Other: *See next page*

1. The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

2. The instant substitute specification has been approved for entry. As to filing of a proper substitute specification, this requirement is deemed satisfied.

3. The remarks have /request for reconsideration has/ been considered to the extent set forth herein. Upon such consideration, the remarks are found to embody new matter, and thus said remarks will not be entered, for reasons set forth in the next paragraph. Since the reply does not comply with the rules, and since the procedure for after final prosecution does not permit additional time, the time for submission of a responsive reply continues to run from the date of the Final Rejection, Paper No. 13, dated December 02, 2003. As the reply is not responsive, the mere filing of an APPEAL will FAIL to satisfy the prior requirement for compliance with 37 CFR 1.121, set forth in Paper No. 13, paragraph 2 on page 2 of the Final Rejection. The mere filing of an appeal without a proper, enterable response presenting arguments, without new matter, to the reasons fully set forth in support of the rejection of record, will result in a holding of abandonment of this application for failure to take such action as was required in said Paper No. 13.

4. The following instances of new matter are found in the remarks. On page 6, the reply introduces new matter when it states that a microemulsion is not an emulsion. Applicant has pointed to no basis in the specification or prior art for the proposition that the generic term "emulsion" is somehow not generic to a "microemulsion", or that a "microemulsion" is "not ... a

water-in-oil emulsion", set forth in line 24. That is, no support is presented for arguing as fact that somehow a microemulsion is chemically not one kind or species of emulsion. This new matter is repeated in various places, including on page 7, line 25. This allegation lacks basis in the specification as filed or in Binet et al. '184. From Binet et al. '184, col. 3, lines about 17-27, the term "microemulsions" denotes cell size for what is still within the genus of a "water-in-oil" emulsion, line 25. One might as well urge that polyisobutylene is somehow not polyalk(en)yl, derived from a polyolefin. Compare Binet et al. '184, col. 5, lines 44-46, also at col. 5, lines 29-31.

5. The question of the benefit or the basis in the original priority document will not be debated further, as resolution of this question is unnecessary. This does not lessen applicant's duty of disclosure, compare MPEP 2004, item 14, and, e.g., *In re Ruscetta,* 255 F.2d 687, 690-91, 118 USPQ 101, 104 (CCPA 1958), therein.

6. Applicant may note that the question of new matter set forth in paragraph 4 above, is distinct from whether the emulsifier of Example 50 is a PIBSA emulsifier, which reasonably is arguable or a question of obviousness, distinct from new matter. However, Binet et al. '184, at the end of the Abstract, uses the terms of graft, block and amphiphatic more or less alternately, also at col. 3, lines 46-56 and at the end of the patent claim 1. In claims 2-5, the term amphiphatic is used to apply to all the polymeric emulsifiers. Likewise, the polymeric emulsifiers are described as four types, A-D, described in the following description, col. 3, line 64, col. 5, line 19, col. 6, lines 2 and 43. The "block" term is found in col. 6, lines 49 and 52, which clarifies that this term applies to the A-D polymeric emulsifiers, including the type B polyesters, with a block of polyisobutylene joined to a block of polyalkylene glycol by the succinic moiety, or alternately a polyethyleneimine moiety in replacement of the polyalkylene glycol. The polyalkylene glycol content is from 10-80%, preferably 20-60%, in the case of the polyester of the B polymeric emulsifier, at col. 5, lines 33-35. However,

the question of B polymeric emulsifier vs. B polymeric component (col. 4, line 16, e.g.) of one of the A-D polymeric emulsifiers is arguable. This does not involve new matter, but a question of obviousness or interpretation. This explanation is not to argue any specific interpretation of Binet et al. '184, but to point out that no issue of new matter relates to this question. Thus, this argument would not preclude entry of a response containing such argument.

7. The delay in this response to applicant's after final submission, caused by scanning failures relating to the use of the electronic file wrapper via eDAN and IFW, is regretted. However, applicant's filing of a reply at (or prior to) 2 months has at least resulted in a partial automatic extension of time as set forth on form PTOL-303. The Office has an outstandingly bad record as to its scanning operations in support of the electronic file wrapper, in the opinion of this examiner.

8. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
April 4, 2004

EDWARD A. MILLER
PRIMARY EXAMINER